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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,714	09/21/2006	Elisabeth Meyer	930008-2207	5929

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EXAMINER

CHEN, CATHERYNE

ART UNIT	PAPER NUMBER
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1655

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11/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/569,714	Applicant(s) MEYER ET AL.	
	Examiner CATHERYNE CHEN	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 0209.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 12-29 is/are pending in the application.
- 4a) Of the above claim(s) 6, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 12-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Currently, Claims 1-3, 5-6, 12-29 are pending. Claims 1-3, 5, 12-29 are examined on the merits. Claims 4, 7-11 are canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Aug. 27, 2009 has been entered.

Election/Restrictions

Claims 6-7, 9-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Nov. 16, 2007.

Applicant's election with traverse of the species matrix type patch, synthetic rubber, styrene-butadiene-styrene-block-copolymer, polybutylacrylate, N-methyl-pyrrolidone, organic acids, polyester in the reply filed on Nov. 16, 2007 is acknowledged.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5, 12-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 1 is objected to because of the following informalities: A claim needs to be in one sentence. There is a period after the word "copolymer." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5, 12-14, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinsorgen et al. (US 6165499).

Kleinsorgen et al. teaches a transdermal therapeutic system for the controlled release of active substances to human skin (column 1, lines 10-12), where a matrix system consists of a backing layer which is impermeable to active substances and auxiliaries and averted from the skin and an adhesive layer wherein active substance is distributed (column 1, lines 48-51). Components include any conventional adhesive known to the skilled artisan in the form of patches (column 4, lines 62-64). Thus, a matrix type patch is taught. The substrate may be peeled off the film layer, with the film layer remaining on the site of application (column 4, lines 25-28). The film forming polymers include styrene-butadiene-styrene-isoprene copolymers (column 4, lines 39-40, 54-55). The active substances serve to treat diseases (column 5, lines 23-25). Thus, application to skin of a person in need thereof is taught. Transdermal applicable active ingredients include opioid substances such as buprenorphine (column 5, lines 44-45, 67). Aloe vera can be used to care for exhausted and damaged skin (column 6, lines 34-35, 37-38).

However, Kleinsorgen et al. does not teach all the claimed components together.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining

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them flows logically from their having been used individually in the prior art. *In re Sussman*, 136 F.2d 715, 718, 58 USPQ 262, 264 (CCPA 1943); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). *In re Kerkhoven*, 626 F. 2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose).

The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103.
<http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2144.htm>

The reference does teach that each of the claimed ingredients is suitable for combination in a pharmaceutical composition. Thus, an artisan of ordinary skill would be reasonably expected that the claimed ingredient could be combined together to produce a single pharmaceutical product. This reasonable expectation of success would motivate the artisan to combine the claimed ingredients together into a single composition.

Claims 1-3, 5, 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinsorgen et al. (US 6165499) as applied to claims 1-3, 5, 12-14, 28-29 above, and further in view of Fischer et al. (US 6455066 B1).

Kleinsorgen et al. teaches a transdermal therapeutic system for the controlled release of active substances to human skin (column 1, lines 10-12), where a matrix system consists of a backing layer which is impermeable to active substances and auxiliaries and averted from the skin and an adhesive layer wherein active substance is distributed (column 1, lines 48-51). Components include any conventional adhesive known to the skilled artisan in the form of patches (column 4, lines 62-64). Thus, a matrix type patch is taught. The film forming polymers include styrene-butadiene-styrene-isoprene copolymers (column 4, lines 39-40, 54-55). The active substances serve to treat diseases (column 5, lines 23-25). Thus, application to skin of a person in need thereof is taught. Transdermal applicable active ingredients include opioid substances such as buprenorphine (column 5, lines 44-45, 67). Aloe vera can be used to care for exhausted and damaged skin (column 6, lines 34-35, 37-38).

However, Kleinsorgen et al. does not teach soybean oil, polyolefin, polyester, polyolefin oil, foil with thickness of 0.5 to 1.5 and especially 0.6 to 1.0 mm, penetrating agent N-methyl pyrrolidone, organic acid.

Fischer et al. teaches dermal drug for formulations and penetrating agents for transdermal administration with vegetable oil, such as soybean oil (column 2, lines 11-12). A patch comprising a pressure sensitive adhesive comprising pharmaceutically

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acceptable salt and soybean oil (Claim 1), with aloe vera (Claim 2), backing is polyolefin, polyester, (Claim 4), polyolefin foil (Claim 5), with thickness of from about 0.6 mm to about 1.0 mm (Claim 6). Local anesthetic can be acetylsalicylic acid as an organic acid, buprenorphine and pharmaceutically acceptable salts thereof (column 5, lines 41-42, 44-46, 60-61). Penetration agents of N-methyl pyrrolidone (column 7, lines 9, 14).

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman*, 136 F.2d 715, 718, 58 USPQ 262, 264 (CCPA 1943); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). *In re Kerkhoven*, 626 F. 2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose).

The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103.
<http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2144.htm>

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a patch with soybean oil, polyolefin, polyester, polyolefin oil, foil with thickness of 0.5 to 1.5 and especially 0.6 to 1.0 mm, penetrating agent N-methyl pyrrolidone, organic acid because these are components are used in a patch for application to skin. One would have been motivated to make a patch for skin for the expected benefit of increasing skin penetration and effective application on a patch formulation as taught by Fischer et al. Absent evidence to the contrary, there would have been a reasonable expectation of success in making the claimed invention from the combined teachings of the cited references.

Conclusion

No claim is allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen
Examiner Art Unit 1655

/Michael V. Meller/

Primary Examiner, Art Unit 1655